

III. REMARKS

This document is being submitted in Response to the Office communication of September 18, 2006. The relevant prosecution history of the present patent application is as follows:

- (i) the Applicant filed the present application on April 16, 2004;
- (ii) the Patent Office issued an Election of Species Requirement on January 21, 2005, to which the Applicant responded on February 22, 2005 by electing Species A (claims 1-10), the light-dispersing medium being a solid, and by adding new claim 21, which was believed to be generic to both species of invention;
- (iii) the Patent Office issued a first Office Action on the merits on March 21, 2005 rejecting claims 1-10 and 21 under 35 USC §102(b) and §103(a) based on various combinations of cited references;
- (iv) the Applicant filed a first Response and Amendment on September 21, 2005;
- (v) the Patent Office issued a Notice of Non-Compliant Amendment on September 30, 2005, requiring a correction to the listing of claims in the first Response and Amendment;
- (vi) the Applicant filed a reply to the Notice of Non-Compliant Amendment on October 24, 2005, and provided a revised listing of claims;
- (vii) the Patent Office issued an Office Communication on January 11, 2006, indicating that the Applicant's reply of October 24, 2005 was not fully responsive; however, the October 24, 2005 reply was considered a *bona fide* attempt to reply;
- (viii) the Applicant filed a reply on February 13, 2006, which addressed the concerns of the Patent Office regarding the Applicant's attempted reply of October 24, 2005;
- (ix) the Patent Office issued another Office Communication on May 02, 2006, indicating that the Applicant's reply of February 13, 2006 was problematic; however, the February 13, 2006 reply was considered another *bona fide* attempt to reply;
- (x) the Applicant filed another reply on June 30, 2006, which addressed the concerns of the Patent Office regarding the Applicant's attempted reply of February 13, 2006;

(xi) the Patent Office issued another Office Communication on September 18, 2006 indicating that the Applicant's reply of June 30, 2006 was not fully responsive; however, the June 30, 2006 reply was considered another *bona fide* attempt to reply;

(xii) the Applicant's representative contacted Examiner Ricky D. Shafer by telephone on Monday November 6, 2006 to discuss the present application and the claims at issue; based on this discussion, on November 7, 2006 the Applicant's representative faxed a proposed set of amended claims to Examiner Shafer for his consideration; and on November 9, 2006, Examiner Shafer indicated in a voice mail to the Applicant's representative that the proposed claim set appeared to address the Patent Office's concerns with the Applicant's previously attempted replies;

(xiii) based on Examiner Shafer's suggestions, the Applicant filed an Amendment and Response on November 15, 2006, which re-introduced original claims 1-4, 8, and 21 and provided amendments thereto to address the rejections of these claims in the Office Action of March 21, 2005; and

(xiv) the Patent Office issued a Notice of Non-Complaint Amendment on December 1, 2006, indicating that the Applicant's Reply of November 15, 2006 did not include the proper status identifier for the amended claims; the Applicant's representative again spoke with Examiner Shafer on December 20, 2006, who indicated that the amended claims in the Amendment and Response of November 15, 2006 must be presented as new claims due to the fact that the Applicant's reply of October 24, 2005 had actually been entered by the Patent Office.

Thus, based on the current understanding between the Patent Office and the Applicant, the present Amendment and Response is submitted to address the Office Communication of September 18, 2006, which indicated that claims 22-40 were not readable on the elected species. Thus, claims 1-4, 8, and 21, which were re-introduced and amended in the Amendment and Response of November 15, 2006 have been removed and re-presented as new claims 41-46. The new claims are consistent with and supported by the application as originally filed and no new matter has been added.

35 USC § 102(b) and 35 USC § 103(a)

On pages 3-6 of the Office Action of March 21, 2005 (the only action on the merits in this case), the Patent Office rejected the following claims under 35 USC § 102(b): claim 21 as being anticipated by Moultrie (U.S. Pat. No. 3,659,927); claims 1, 6, and 10 as being anticipated by Miller (U.S. Pat. No. 2,594,334); claim 1, 6, and 7 as being anticipated by Pickering (U.S. Pat. No. 2,983,183); claims 1, 6, 10, and 21 as being anticipated by Maleish (U.S. Pat. No. 2,669,899); claims 1, 2, 6, 8 and 10 as being anticipated by Miller (U.S. Pat. No. 3,880,499); and claims 1-6 and 8-10 as being anticipated by Staunton (U.S. Pat. No. Re. 26,617). On pages 6-9 of the Office Action, the Patent Office rejects claims 8 and 9 under 35 USC § 103(a) as being unpatentable over Miller ('334) or Macleish ('899) in view of Beloian (U.S. Pat. No. 2,874,608); claims 1 and 5-10 as being unpatentable over Beloian ('608) in view of Miller ('334) or Macleish ('899); and claims 7 and 21 as being unpatentable over Staunton ('617).

MPEP 2131 provides that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP provides that "to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Original claim 5-7 and 9-10 have been cancelled, rendering moot further discussion thereof. Original claims 1-4, 8 and 21 have been cancelled and re-introduced as new claims 41-46 to address the election of species issue raised by the Patent Office and to emphasize and clarify that the present invention is primarily a white light dispersion device that creates colorful

spectral displays by reflecting dispersed light out of the device in a predictable and controllable manner. This predictability and control results from the dispersed light being reflected back out of the device through the same optically active surface or "window" that initially receives the white light, and from the fact that the angle between the planar window and the planar reflective surface is fixed. Thus, the Applicant's monolithic prismatic element may be accurately "aimed" at a target surface for the purpose of creating spectral displays on that target surface. Previously presented claims 22-40 also emphasize these aspects of the present invention. None of the prior art references cited by the Patent Office in the present Office Action includes: "at least one source of white light directed at the window of the at least one prismatic element, wherein white light enters the prismatic element through the window, wherein the light-dispersing medium disperses the white light into the spectrum of visible colors, and wherein the highly reflective surface reflects at least a portion of the dispersed light back out of the prismatic element through the window for creating a colorful spectral display." All of the previously presented claims and new independent claims (and their associated dependent claims) include these interrelated limitations in one form or another; thus, the claims presented herein are believed to define patentably over both the 102(b) and 103(a) art cited against the Applicant by the Patent Office. For at least these reasons, the Applicant believes that these claims define patentably over the cited art and respectfully requests consideration thereof.

Respectfully submitted,

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